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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
033,234	04/25/79	Valentino J. Stella, et al.,	NHSRX52A

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EXAMINER	
Fan	
ART UNIT	PAPER NUMBER
121	7

MAILED

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

FEB 7 1980

GROUP 120

This application has been examined.

Responsive to communication filed on

1/7/80

This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), days from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited, Form PTO-892.
2. Notice of Informal Patent Drawing, PTO-948.
3. Notice of Informal Patent Application, Form PTO-152.
4. _____

Part II SUMMARY OF ACTION

1. Claims 24 - 30 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 24 - 30 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. The formal drawings filed on _____ are acceptable.

8. The drawing correction request filed on _____ has been approved. disapproved.

9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
 been received. not been received. been filed in parent application, serial no. _____

filed on _____

10. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

11. Other

Claims 24, 27 and 29 are rejected under 35 USC 103 as being obvious over German Offenlegungsschrift 2,064,474 and the French patent 1,093,728 considered together for reasons of record. In traversing the rejections, applicants place great emphasis on the differences in the properties disclosed in the art and in applicants' specification. However, it is not believed that the differences in phosphoric acid or ester group would effect the properties of the claimed compounds since the anticonvulsant or antiarrythmic activity is due to the presence of 5,5-diphenyl-hydantoin nucleus. Thus, in order to rebut this *prima facie* case of obviousness, actual differences in fact of an unexpected nature must be shown since compounds which are very similar in structures would be expected to have similar properties. *In re Hoch*, 166 USPQ 406.

Claims 25 to 29 are rejected under 35 USC 132 as being drawn to new matter and 35 USC 112, paragraph 1. The claims encompass new subgeneric concepts which are not disclosed anywhere in the specification. The description of only one compound, 3-phosphoryloxymethyl-diphenylhydantoin (page 7) is not sufficient to implicitly or explicitly support the new subgeneric groups of compounds encompassed by the claims. Thus the claims are drawn to new matter.

Claim 30 is rejected under 35 USC 112, paragraph 2. The claim is improper since it depends on a cancelled claim.

Furthermore, the position of the two phenyl groups should be specified.

Claims 24 to 30 are rejected. The rejection is made FINAL.

JTFan/j1b
A/C 703
557-2517
02/05/80


JOHN M. FORD
EXAMINER
GROUP ART UNIT 121